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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,103	01/17/2002	Akira Date	500.37453CX3	6766
20457 7590 10/28/2010 ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873				
EXAMINER				
JONES, HEATHER RAE				
ART UNIT		PAPER NUMBER		
2481				
MAIL DATE		DELIVERY MODE		
10/28/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/047,103

Applicant(s)

DATE ET AL.

Examiner

HEATHER R. JONES

Art Unit

2481

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/369,401.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed August 17, 2010 have been fully considered but they are not persuasive.

The Applicant argues that Matsumoto et al. fails to disclose still picture management group information provided separately from any still picture management information containing management information for each still picture, wherein the still picture group management information contains a first recording time and a last recording time. The Examiner respectfully disagrees. Matsumoto et al. discloses in Fig. 11 picture data for a single still picture wherein in this file both the attribute data and the image data are stored. Part of the attribute data includes the year, month, day, and time the still picture was taken. Furthermore, Fig. 12 displays an album list that can be generated using Fig. 19. The album list includes the year, month, day, and time of when every still picture in the album was taken. The album list itself does not contain the image data therefore it is separate from the actual picture which itself contains the image data and attribute data in the file as can be seen in Fig. 11. Furthermore, the album list in Fig. 12 shows the pictures in chronological order and thereby looking at the first and last entry on the list the user can see what the first and last recording times were. Therefore, Matsumoto et al. in view of Kobayashi meet the claimed limitations and the rejection is maintained.

The Applicant argues that Kobayashi is an irrelevant reference because it is directed to video programs and not still pictures. The Examiner respectfully disagrees. It is well-known in the art that video programs are made up of a combination of still images. Furthermore, as can be seen from Fig. 4 of the Kobayashi reference, Kobayashi clearly discloses that the video program information includes only the recording start and end times of that program. Furthermore, Matsumoto et al. already teaches separately stored still images along with group information that includes recording times of each image and the Examiner was only relying on Kobayashi to only teach the group information to include the recording start and end times of the group, the group being the video program, which is made up of a group of still images as well. Therefore, the combination of the Matsumoto et al. reference and the Kobayashi reference meets the claimed limitations and the rejection is maintained.

2. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 7, 8, 10, 11, 13-15, 18, 19, 21, 22, and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 2, 7, 8, 10, 11, 13-15, 18, 19, 21, 22, and 24 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. For example the method including steps managing and comparing recording times of N still picture data is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The Applicant has provided no explicit and deliberate definitions of "managing" or "comparing" to limit the steps to the electronic form of the method, and the claim language itself is sufficiently broad to read on a person being able to mentally stepping through the §101 analysis, recalling *In re Bilski*.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 2, and 5-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (U.S. Patent 5,796,428) in view of Kobayashi (U.S. Patent 6,108,728).

Regarding claim 1, Matsumoto et al. discloses a method for recording still picture data of N still pictures stored in separate N files, respectively, and for recording still picture group management information for managing N still picture data of said N still pictures as a still picture group, onto a storage medium, where N is an integer number equal to or larger than one, wherein said still picture group management information includes time information and is provided separately from any still picture management information containing management information for each still picture, and said time information of said still picture group management information includes a first recording time at which the still picture data of an earliest-photographed still picture in said still picture group was recorded first by a picture-taking device, and a last recording time at which the still picture data of a latest-photographed still picture in said still picture group was recorded last by the picture-taking device (Fig. 11 – detailed structure of a picture data - col. 10, lines 39-50; Fig. 19 - flowchart for generating an album list where the generation condition can be set, for example, according to time - col. 3, lines 18-36 and col. 11, line 59 – col. 12, line 10; - the album list shows the earliest and last recording times; it can be seen from Fig. 11 and Fig.

15 the difference in the management information for a group and a separate image), said method comprising: comparing a recording time of the still picture data of a still picture, with said first recording time stored in said still picture group management information corresponding to the still picture group belonging to said still picture data; and if said recording time is earlier than said first recording time, replacing the content of said first recording time by said recording time and performing recording thereof (col. 11, line 59 – col. 12, line 45 – the album list is updated accordingly when the list is set according to the date and time an image is taken and when the album is edited the list is updated. Therefore, the earliest and last recording times will be the first and last recording times on the list which are updated accordingly). Furthermore, Matsumoto et al. discloses still picture group management information that includes a list of still images in the group as well as updating the times in the list accordingly when the album is edited (Fig. 19), but fails to disclose the still picture group management information only stores the earliest and latest recording times.

Referring to the Kobayashi reference, Kobayashi discloses a method of recording still picture data and still picture group management information for managing N still pictures data as a still picture group onto a storage medium, where said N is an integer number equal to or greater than one, comprising the steps of: recording a first recording time at which the still picture data in the still picture group was recorded first and a last recording time at which the still picture data in the still picture group was recorded last in the still picture group

management information (Fig. 4 discloses an index wherein for each group of video the start and end times are recorded in the index; col. 8, lines 50-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have only stored the earliest and latest recording times in the still picture group management information as disclosed by Kobayashi in the method disclosed by Matsumoto et al. in order to reduce the size of the management data.

Regarding claim 2, Matsumoto et al. in view of Kobayashi discloses all the limitations as previously discussed with respect to claim 1 as well as further disclosing comparing a recording time of said still picture data of said still picture, with said last recording times stored in said still picture group management information corresponding to the still picture group belonging to said still picture data; and if the recording time is later than said last recording time, replacing the content of said last recording time by said recording time and performing recording thereof (Matsumoto et al.: col. 11, line 59 – col. 12, line 45 – the album list is updated accordingly when the list is set according to the date and time an image is taken and when the album is edited the list is updated. Therefore, the earliest and last recording times will be the first and last recording times on the list which are updated accordingly; Kobayashi: Fig. 4 discloses an index wherein for each group of video the start and end times are recorded in the index; col. 8, lines 50-67).

Regarding claims **5** and **6**, these are non-transitory computer-readable storage medium claims corresponding to the method claims 1 and 2. Therefore, claims 5 and 6 are analyzed and rejected as previously discussed with respect to claims 1 and 2. Furthermore, Matsumoto et al. discloses a computer (Fig. 1) that performs the method disclosed in claims 1 and 2.

Regarding claim **7**, Matsumoto et al. discloses a method of recording still picture data of N still pictures stored in separate N files, respectively, and for recording still picture group management information for managing N still picture data of said N still pictures as a still picture group onto a storage medium, where said N is an integer number equal to or greater than one, wherein said still picture group management information includes time information and is provided separately from any still picture management information containing management information for each still picture, said method comprising: recording, as said time information of the still picture group management information, a first recording time at which the still picture data of an earliest-photographed still picture in said still picture group was recorded first by picture-taking device, and a last recording time at which the still picture data of a latest-photographed still picture in said still picture group was recorded last by the picture-taking device (Fig. 11 – detailed structure of a picture data - col. 10, lines 39-50; Fig. 19 - flowchart for generating an album list where the generation condition can be set, for example, according to time - col. 3, lines 18-36 and col. 11, line 59 – col. 12, line 10; - the album list shows the earliest and last recording

times; it can be seen from Fig. 11 and Fig. 15 the difference in the management information for a group and a separate image). Furthermore, Matsumoto et al. discloses still picture group management information that includes a list of still images in the group as well as updating the times in the list accordingly when the album is edited (Fig. 19), but fails to disclose the still picture group management information only stores the earliest and latest recording times.

Referring to the Kobayashi reference, Kobayashi discloses a method of recording still picture data and still picture group management information for managing N still pictures data as a still picture group onto a storage medium, where said N is an integer number equal to or greater than one, comprising the steps of: recording a first recording time at which the still picture data in the still picture group was recorded first and a last recording time at which the still picture data in the still picture group was recorded last in the still picture group management information (Fig. 4 discloses an index wherein for each group of video the start and end times are recorded in the index; col. 8, lines 50-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have only stored the earliest and latest recording times in the still picture group management information as disclosed by Kobayashi in the method disclosed by Matsumoto et al. in order to reduce the size of the management data.

Regarding claim 8, Matsumoto et al. in view of Kobayashi discloses all the limitations as previously discussed with respect to claim 1 including that the

storage medium is an optical disk, and where said method comprising recording said still picture data of said N still pictures and said recording still picture group management information in the optical disk using an optical recording device (Matsumoto et al.: col. 7, lines 38-40 and col. 8, lines 6-11).

Regarding claim **9**, this is a non-transitory computer-readable storage medium claim corresponding to the method claim 8. Therefore, claim 9 is analyzed and rejected as previously discussed with respect to claim 8.

Regarding claim **10**, grounds for rejecting claim 8 apply for claim 10 in its entirety.

Regarding claim **11**, Matsumoto et al. in view Kobayashi discloses all the limitations as previously discussed with respect to claim 1 including that N is an integer number larger than one (Matsumoto et al.: Fig. 12 - more than one image is shown being listed in the album, Fig. 11 - the makeup of a picture file wherein each picture is stored separately from other pictures).

Regarding claim **12**, this is a non-transitory computer-readable storage medium claim corresponding to the method claim 11. Therefore, claim 9 is analyzed and rejected as previously discussed with respect to claim 8.

Regarding claim **13**, grounds for rejecting claim 11 apply for claim 13 in its entirety.

Regarding claim **14**, Matsumoto et al. discloses a method for recording still picture data of N still pictures stored in separate N files, respectively, and for recording still picture group management information for managing N still picture

data of said N still pictures as a still picture group, onto a storage medium, where N is an integer number equal to or larger than one, wherein said still picture group management information is provided separately from any still picture management information containing management information for each still picture, and said still picture group management information includes a recording time data which specify the recording times, all of the recording times in said still picture group management information comprises a first recording time at which the still picture data of an earliest-photographed still picture in said still picture group was recorded first by a picture-taking device, and a last recording time at which the still picture data of a latest-photographed still picture in said still picture group was recorded last by the picture-taking device (Fig. 11 – detailed structure of a picture data - col. 10, lines 39-50; Fig. 19 - flowchart for generating a an album list where the generation condition can be set, for example, according to time - col. 3, lines 18-36 and col. 11, line 59 – col. 12, line 10; - the album list shows the earliest and last recording times; it can be seen from Fig. 11 and Fig. 15 the difference in the management information for a group and a separate image), said method comprising: comparing a recording time of said still picture data of a still picture, with said first recording time stored in said still picture group management information corresponding to the still picture group belonging to said still picture data; and if said recording time is earlier than said first recording time, replacing the content of said first recording time by said recording time and performing recording thereof (col. 11, line 59 – col. 12, line 45 – the album list is

updated accordingly when the list is set according to the date and time an image is taken and when the album is edited the list is updated. Therefore, the earliest and last recording times will be the first and last recording times on the list which are updated accordingly). Furthermore, Matsumoto et al. discloses still picture group management information that includes a list of still images in the group as well as updating the times in the list accordingly when the album is edited (Fig. 19), but fails to disclose the still picture group management information consists of either the earliest and latest recording times.

Referring to the Kobayashi reference, Kobayashi discloses a method of recording still picture data and still picture group management information for managing N still pictures data as a still picture group onto a storage medium, where said N is an integer number equal to or greater than one, comprising the steps of: recording a first recording time at which the still picture data in the still picture group was recorded first and a last recording time at which the still picture data in the still picture group was recorded last in the still picture group management information (Fig. 4 discloses an index wherein for each group of video the start and end times are recorded in the index; col. 8, lines 50-67 – regarding the time information the index consists of the earliest and latest recording times).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have only stored the earliest and latest recording times in the still picture group management information as disclosed by

Kobayashi in the method disclosed by Matsumoto et al. in order to reduce the size of the management data.

Regarding claim **15**, grounds for rejecting claim 2 apply for claim 15 in its entirety.

Regarding claims **16** and **17**, these are non-transitory computer-readable storage medium claims corresponding to the method claims 14 and 15. Therefore, claims 16 and 17 are analyzed and rejected as previously discussed with respect to claims 14 and 15. Furthermore, Matsumoto et al. discloses a computer (Fig. 1) that performs the method disclosed in claims 14 and 15.

Regarding claim **18**, Matsumoto et al. discloses a method of recording still picture data of N still pictures stored in separate N files, respectively, and for recording still picture group management information for managing N still pictures data of said N still pictures as a still picture group onto a storage medium, where said N is an integer number equal to or greater than one, wherein said still picture group management information is provided separately from any still picture management information containing management information for each still picture, said method comprising: recording, as part of said still picture group management information, a recording time data which specify the recording times, all of the recording times in said still picture group management information comprises a first recording time at which the still picture data of an earliest-photographed still picture in said still picture group was recorded first by picture-taking device, and a last recording time at which the still picture data of a

latest-photographed still picture in said still picture group was recorded last by the picture-taking device (Fig. 11 – detailed structure of a picture data - col. 10, lines 39-50; Fig. 19 - flowchart for generating a an album list where the generation condition can be set, for example, according to time - col. 3, lines 18-36 and col. 11, line 59 – col. 12, line 10; - the album list shows the earliest and last recording times; it can be seen from Fig. 11 and Fig. 15 the difference in the management information for a group and a separate image). Furthermore, Matsumoto et al. discloses still picture group management information that includes a list of still images in the group as well as updating the times in the list accordingly when the album is edited (Fig. 19), but fails to disclose the still picture group management information consists of either the earliest and latest recording times.

Referring to the Kobayashi reference, Kobayashi discloses a method of recording still picture data and still picture group management information for managing N still pictures data as a still picture group onto a storage medium, where said N is an integer number equal to or greater than one, comprising the steps of: recording a first recording time at which the still picture data in the still picture group was recorded first and a last recording time at which the still picture data in the still picture group was recorded last in the still picture group management information (Fig. 4 discloses an index wherein for each group of video the start and end times are recorded in the index; col. 8, lines 50-67 –

regarding the time information the index consists of the earliest and latest recording times).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have only stored the earliest and latest recording times in the still picture group management information as disclosed by Kobayashi in the method disclosed by Matsumoto et al. in order to reduce the size of the management data.

Regarding claim **19**, grounds for rejecting claim 8 apply for claim 19 in its entirety.

Regarding claim **20**, this is a non-transitory computer-readable storage medium claim corresponding to the method claim 19. Therefore, claim 20 is analyzed and rejected as previously discussed with respect to claim 19.

Regarding claim **21**, grounds for rejecting claim 8 apply for claim 21 in its entirety.

Regarding claim **22**, grounds for rejecting claim 11 apply for claim 22 in its entirety.

Regarding claim **23**, this is a non-transitory computer-readable storage medium claim corresponding to the method claim 22. Therefore, claim 23 is analyzed and rejected as previously discussed with respect to claim 22.

Regarding claim **24**, grounds for rejecting claim 11 apply for claim 24 in its entirety.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEATHER R. JONES whose telephone number is (571)272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heather R Jones
Examiner
Art Unit 2481

HRJ
October 23, 2010

Application/Control Number: 10/047,103

Page 17

Art Unit: 2481

/Peter-Anthony Pappas/

Supervisory Patent Examiner, Art Unit 2481